

Serial No. 09/602,049

Docket No. 380112-141

**REMARKS****I. PRELIMINARY REMARKS**

Claims 1, 3, 11, 19, 20 and 30 have been amended. Claims 2, 4 and 16 have been canceled. No claims have been added. Claims 1, 3, 5-15 and 17-35 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

**II. PRIOR ART REJECTIONS – CLAIMS 1-18****A. Rejection Based On Roy**

Claims 1-3, 8-10, 15, 17 and 18 have been rejected under 35 U.S.C. § 102 as being anticipated by the Roy patent. The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

Independent claim 1 has been rewritten so as to include the limitations originally presented in now canceled claim 4, which was dependent on claim 1. As claim 4 was not rejected under 35 U.S.C. § 102 (based on Roy), applicant respectfully submits that the rejection of claims 1-3, 8-10, 15, 17 and 18 under 35 U.S.C. § 102 has been obviated and should be withdrawn. *ayel*

**B. Rejections Based on Lauraitis**

Claims 1, 4, 5, 7 and 11 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lauraitis and Roy patents. Claims 1, 5 and 6 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lauraitis and Jackson patents. Claims 1 and 11-14 have been

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rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lauraitis and Takezawa patents. The rejections under 35 U.S.C. § 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

Independent claim 1 has been rewritten so as to include the limitations originally presented in now canceled claim 2, which depended from claim 1. As claim 2 was not rejected under 35 U.S.C. § 103 (based on Lauraitis/Roy, Lauraitis/Jackson or Lauraitis/Takezawa), applicant respectfully submits that the rejections of claims 1, 4, 5-7 and 11-14 under 35 U.S.C. § 103 have been obviated and should be withdrawn.

#### **C. Rejections Based on Takezawa**

Claim 16 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Takezawa and Lauraitis patents. As claim 16 has been canceled, applicant respectfully submits that the rejection thereof under 35 U.S.C. § 103 has been rendered moot.

### **III. PRIOR ART REJECTIONS – CLAIMS 19-35**

#### **A. The Rejections**

Claims 19-22 and 24-35 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Takezawa and Lauraitis patents. Claim 23 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Takezawa, Lauraitis and Jackson patents. The rejections under 35 U.S.C. § 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

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## B. The Claimed Combinations

Independent claim 19 calls for a combination of elements including "a plurality of resin layers defining a tip, a tip section, a main body section, a grip section, and a butt, at least one of the resin layers being a fiber reinforced resin layer," **"a plurality of first metal fibers located between two of the resin layers and defining a first length"** and **"a plurality of second metal fibers located between two of the resin layers, the second metal fibers being formed from a different metal than the first metal fibers and defining a second length that is greater than the first length."**

Independent claim 34 calls for a combination of elements including "a plurality of fiber reinforced resin layers," "a plurality of relatively heavy metal fibers ... defining a first length and located between two of the fiber reinforced resin layers," "a plurality of relatively stiff metal fibers ... defining a second length and located between two of the fiber reinforced resin layers, the **second length being greater than the first length**" and "a plurality of relatively resilient metal fibers ... defining a third length and located between two of the fiber reinforced resin layers, the **third length being greater than the second length.**"

## C. Discussion

In *Winner International Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1144 (Fed. Cir. 1998), the Federal Circuit reiterated the fundamental rule that "it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art." To the contrary, "there must have been some **explicit** teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention." *Id.* [Emphasis added.] Thus, "[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed.

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Cir. 1992). Applicant respectfully submits that the combination of references proposed in the Office Action fails to meet the standard enumerated by the Federal Circuit.

The Takezawa patent discloses a variety of hybrid prepreg sheets that include resin reinforcing fibers 2 (such as carbon fibers) and a plurality of additional foreign fibers 6. Referring more specifically to Figure 11 and column 11, lines 38-56, the Takezawa foreign fibers 6 may be composed of two different types of fibers, such as boron fibers and titanium fibers, which are numbered 6A and 6B. In contrast to the combinations respectively defined by independent claims 19 and 34, however, nothing in the Takezawa patent even remotely suggests that the length of fibers 6A is different than the length of fibers 6B.

The Office Action relies on the teachings of the Lauraitis patent to overcome the above-identified deficiencies in the Takezawa patent. The Lauraitis patent discloses a shaft including a number of conventional fiber reinforced resin layers that are arranged in such a manner that the shaft purportedly feels like a steel shaft. The Lauraitis patent teaches varying the angles of the fibers in the fiber reinforced resin layers to obtain the desired feel. [Column 1, lines 28- 43.] The Lauraitis patent also teaches that, ***in order to form the taper and vary the finished diameter***, the length of some of the individual fiber reinforced resin layers will be less than the full length of the shaft. [Column 2, lines 36-47.] In contrast to the presently claimed combinations, however, there is nothing in the Lauraitis patent that even remotely suggests that its teachings are applicable to shafts formed from fiber reinforced resin prepregs, such as those disclosed in the Takezawa patent, which include additional metal fibers. Nor is there anything in the Lauraitis patent that even remotely suggests that if metal fibers formed from two different metals were used in combination with fiber reinforced resin layers, the metal fibers formed from one metal should have a different length than the metal fibers formed from the other metal. As such, the proposed combination of references fails to establish a *prima facie* case of obviousness.

Applicant also respectfully traverses the conclusory statements on page 7, line 15 to page 8, line 5 of the Office Action. These statements are not supported by the

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cited references and, to the contrary, tend to show that the Office Action has "fall[en] victim to the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983). To the extent that these statements were intended to convey that the Examiner has taken "judicial notice" with respect to knowledge generally available in the art, applicant hereby traverses and requests that the Examiner provide an affidavit in accordance with MPEP § 2144.03 and 37 C.F.R. § 1.104(d)(2) to that effect. The affidavit should set forth the facts upon which the Examiner's conclusions regarding the knowledge available in the art are based. Otherwise, applicant respectfully requests that the Examiner provide a prior art reference which shows that the claimed invention would have been obvious.

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#### D. Conclusion

As the cited references fail to teach or suggest the respective combinations of elements recited in independent claims 19 and 34, whether viewed alone or in combination, applicant respectfully submits that the rejection of claims 19-22 and 24-35 under 35 U.S.C. § 103 should be withdrawn.

With respect to claim 23, applicant respectfully submits that the Jackson patent fails to remedy the above-identified deficiencies with respect to the proposed Takezawa/Lauritis combination. As such, claim 23 is patentable for at least the same reasons as claim 19 and the rejection thereof under 35 U.S.C. § 103 should also be withdrawn.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the

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application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

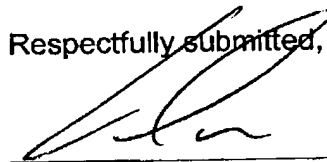
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

11/13/01

Date

Respectfully submitted,



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**VERSION OF AMENDMENTS TO APPLICATION WITH  
MARKINGS TO SHOW CHANGES MADE**

***Claims 1, 3, 11, 19, 20 and 30 have been amended as follows:***

1. (Amended) A golf club shaft, comprising:

a plurality of fiber reinforced resin layers defining a tip, a tip section, a main body section, a grip section, and a butt; and

a plurality of first metal fibers, defining a first length and longitudinal ends, located between two of the fiber reinforced resin layers such that one of the longitudinal ends of each of the first metal fibers is substantially aligned with the tip; and

a plurality of second metal fibers, defining a second length and longitudinal ends, located between two of the fiber reinforced resin layers such that one of the longitudinal ends of each of the second metal fibers is substantially aligned with the tip, the second length being greater than the first length.

3. (Amended) A golf club shaft as claimed in claim [2] 1, wherein the plurality of fiber reinforced resin layers includes a group of layers with fibers angled with respect to the longitudinal axis of the shaft and a group of layers with fibers substantially parallel to the longitudinal axis.

11. (Amended) A golf club shaft as claimed in claim 1, further comprising:

a plurality of third metal fibers defining a third length located between two of the fiber reinforced resin layers, the third length being greater than the second length.

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19. (Amended) A golf club shaft, comprising:

a plurality of resin layers defining a tip, a tip section, a main body section, a grip section, and a butt, at least one of the resin layers being a fiber reinforced resin layer, and

a plurality of first metal fibers located between two of the resin layers and defining a first length; and

a plurality of second metal fibers located between two of the resin layers, the second metal fibers being formed from a different metal than the first metal fibers and defining a second length that is greater than the first length.

20. (Amended) A golf club shaft as claimed in claim 19, wherein each of the plurality of resin layers comprises a plurality of fiber reinforced resin layers.

30. (Amended) A golf club shaft as claimed in claim 29, wherein [the first metal fibers define a first length, the second metal fibers define a second length, and] the third metal fibers define a third length [, the second length being greater than the first length] and the third length [being] is greater than the second length.